IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: David G. Kuehr-McLaren et al.	Group Art Unit: 3621
Application No.: 10/706,334	Examiner: Augustin, Evens J.
Filed: November 12, 2003	Confirmation No.: 6032

For: METHOD, SYSTEM, AND COMPUTER PROGRAM
    PRODUCT FOR DIGITAL VERIFICATION OF
    COLLECTED PRIVACY POLICIES IN ELECTRONIC
    TRANSACTIONS

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37(a)

       This is an appeal to the Board of Patent Appeals and Interferences from the

decision of the Examiner dated February 23, 2010, which finally rejected claims 1-20 in

the above-identified application. The Office date of receipt of Appellants' Notice of

Appeal was May 24, 2010. This Appeal Brief is hereby submitted pursuant to 37 C.F.R.

§ 41.37(a).

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I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the full interest in the invention, International Business Machines Corporation, of Armonk, New York.

II. RELATED APPEALS AND INTERFERENCES

To the best of Appellants' knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.

III. STATUS OF CLAIMS

No claims are canceled.

No claims are withdrawn.

No claims are objected to.

Claims 1-20 stand rejected as follows:

> Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barzilai et al. (U.S. Pat. Pub. No. 2002/0029201, hereinafter Barzilai) in view of Bowman-Amuah (U.S. Pat. No. 6,697,824, hereinafter Bowman).

Claims 1-20 are the subject of this appeal. A copy of claims 1-20 is set forth in the Claims Appendix.

IV. STATUS OF AMENDMENTS

There were no proposed amendments submitted subsequent to the Final Office Action mailed February 23, 2010.

V. SUMMARY OF CLAIMED SUBJECT MATTER

This section of this Appeal Brief is set forth to comply with the requirements of 37 C.F.R. § 41.37(c)(1)(v) and is not intended to limit the scope of the claims in any way. Examples of implementations of the limitations of independent claims 1, 7, and 13 are described below.

The language of claim 1 relates to a computer-implemented method of conducting electronic commerce transactions among a plurality of participants in an E-marketplace. Fig. 3. The method includes the E-marketplace obtaining, via a computer, digitally-signed privacy-use information for each participant. Page 10, lines 4-6; Fig. 3, step 304. The digitally-signed privacy-use information is obtained separate from a business transaction between participants. Page 10, lines 3-7. The method also includes the E-marketplace sharing, via the computer, the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace. Page 10, lines 12-17; Fig. 3, step 308. The sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace. Page 5, lines 11-13; page 8, line 5, through page 9, line 2; page 10, lines 14-17.

The language of claim 7 relates to a computer program product recorded on computer-readable medium for conducting electronic commerce transactions among a plurality of participants in an E-marketplace. Fig. 3; page 12, line 6, through page 13, line 2. The computer program product includes computer-readable means for the E-marketplace obtaining digitally-signed privacy-use information for each participant. Page 10, lines 4-6; Fig. 3, step 304. The digitally-signed privacy-use information is obtained separate from a business transaction between participants. Page 10, lines 3-7. The computer program product also includes computer-readable means for the E-marketplace sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace. Page 10, lines 12-17; Fig. 3, step 308. The sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace. Page 5, lines 11-13; page 8, line 5, through page 9, line 2; page 10, lines 14-17.

The language of claim 13 relates to a computer system for conducting electronic commerce transactions among a plurality of participants in an E-marketplace. Fig. 3; page 12, line 6, through page 13, line 2. The computer system includes logic for obtaining digitally-signed privacy-use information for each participant. Page 10, lines 4-6; Fig. 3, step 304. The digitally-signed privacy-use information is obtained separate

from a business transaction between participants. Page 10, lines 3-7. The computer system also includes logic for sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace. Page 10, lines 12-17; Fig. 3, step 308. The sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace. Page 5, lines 11-13; page 8, line 5, through page 9, line 2; page 10, lines 14-17.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A.   Whether claims 1-20 are patentable over the combination of Barzilai and
       Bowman under 35 U.S.C. § 103(a).

VII. ARGUMENT

For the purposes of this appeal, claims 1-20 are argued together as a group for purposes of the question of patentability over the combination of Barzilai and Bowman under 35 U.S.C. § 103(a).

A.   Claims 1-20 are patentable over the combination of Barzilai and Bowman because
       the combination of cited references does not teach all of the limitations of the
       claims.

Appellants respectfully submit that claim 1 is patentable over the combination of Barzilai and Bowman because the combination of cited references does not teach all of the limitations of the claim. Claim 1 recites:

> A computer-implemented method of conducting electronic
> commerce transactions among a plurality of participants in an E-
> marketplace, comprising the steps of:
>   the E-marketplace obtaining, via a computer, digitally-signed
> privacy-use information for each participant, wherein the digitally-signed
> privacy-use information is obtained separate from a business transaction
> between participants; and
>   the E-marketplace sharing, via said computer, the digitally-signed
> privacy-use information with any participants interested in doing business
> with each other in the E-marketplace, wherein the sharing allows the

> participants to verify that the digitally-signed privacy-use information has
> not been tampered with since being submitted to the E-marketplace.
> (Emphasis added.)

In contrast to the language of the claim, the combination of Barzilai and Bowman does not teach sharing digitally-signed privacy-use information with other business participants. For reference, the Examiner's reasoning relies on Barzilai as teaching sharing privacy-use information and relies on Bowman as teaching digital signatures. However, despite these assertions, Barzilai does not teach sharing privacy-use information. Rather, Barzilai merely describes sharing private information, which is distinct from privacy-use information.

The Examiner's reasoning fails to properly interpret the meaning of the "privacy-use information" recited in the claims. Although the claims of the present application explicitly recite sharing "privacy-use information," the Examiner's reasoning merely refers teachings of Barzilai direct to sharing "private information." However, the private information that is shared in Barzilai is not privacy-use information. Although not illustrated in the figures of Barzilai, the following illustration is consistent with the description of Barzilai and helps to demonstrate the difference between privacy-use information and private information.

As illustrated in the figure, the electronic marketplace of Barzilai uses two types of information: 1) privacy policies (or preferences), and 2) private information. The electronic marketplace of Barzilai serves as a broker of the private information between a buyer and one or more sellers. Barzilai, Paragraph 12. As the broker, the electronic marketplace allows the buyer and seller to specify preferences, including the uses to which the marketplace may put the private information, for their respective privacy policies. Barzilai, Paragraphs 15-17. These privacy preferences are received by the electronic marketplace via a network. Barzilai, Paragraph 22. In order to establish a business transaction between the buyer and seller, the electronic marketplace identified buyers and sellers who have matching privacy policies. Barzilai, Paragraph 14. In the figure illustrated herein, this matching process is schematically illustrated by the "MATCH" block that receives the privacy policies from both the buyer and the seller. If a match is found, then the electronic marketplace facilitates exchanging private

information of the buyer and seller with each other. Barzilai, Paragraph 22. In the figure illustrated herein, this exchange is illustrated by the dashed lines which show sending the buyer's private information to the seller and sending the seller's private information to the buyer.
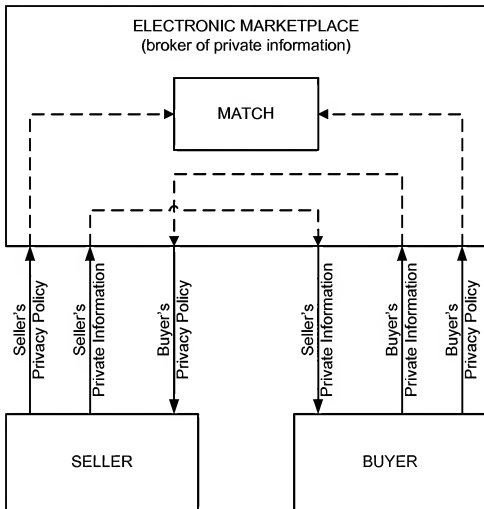

Fig. 1. Operation of the Electronic Marketplace of Barzilai, which shared private information, but does not share privacy policies.

As illustrated in the figure, Barzilai merely uses the privacy policies (or preferences) to identify matching buyers and sellers. However, Barzilai does not teach sharing the buyer's privacy policy with the seller, or sharing the seller's privacy policy with the buyer. Rather, the electronic marketplace of Barzilai merely shares the <u>private information</u> of the parties—not the <u>privacy policies</u>.

The description in Barzilai of exchanging private information between buyers and sellers simply does not teach sharing privacy-use information because the private information of Barzilai is not privacy-use information. Moreover, Barzilai explicitly describes using privacy policies (or preferences) without teaching that the privacy policies might be shared between buyers and sellers because the electronic marketplace acts as an intermediate broker to identify matching privacy policies. Thus, there is no need to exchange privacy policies between buyers and sellers because the intermediate electronic marketplace performs the matching function. Furthermore, there would be no need to digitally sign the privacy policies of Barzilai because the privacy policies are not shared between buyers and sellers and, hence, do not need to be validated as to the source of the information. Also, since digital signatures are used to prevent modifications or other attacks by intermediate parties, and Barzilai does not disclose any intermediate parties between the buyer and the broker marketplace, or between the seller and the broker marketplace, there is no need to use the digital signatures of Bowman for transmissions between the buyer and the marketplace or between the seller and the marketplace.

As an additional matter, the "privacy-use information" recited in the present application should not be interpreted to include the "private information" of Barzilai. Such an interpretation would be <u>too broad</u> and <u>unreasonable</u>. While details of the specification are not read into the limitations of the claim, the broadest <u>reasonable</u> construction must be <u>consistent</u> with the language of the claim and the specification. *In Re Suitco Surface, Inc.* (Fed. Cir. 2010). Any such construction must be <u>consistent with the specification</u>, and claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *Id.* (citing *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)). In that case, the Federal Circuit held that the PTO's claim construction was unreasonable because the asserted claim construction was not consistent with the language of the claim and the specification. Therefore, a claim construction is <u>not reasonable</u> and fails if the construction is <u>not consistent</u> with the context of the specification. Additionally, such an interpretation would be inconsistent with the actual disclosure of Barzilai, which specifically and separately references privacy policies (or preferences) that are distinct from private information.

For reference, the Examiner's reasoning relies on Barzilai as not teaching digitally-signed privacy information. Office Action, 2/23/10, page 5, paragraph 5. Hence, the reasoning in the Office Action relies on a combination of the privacy information described in Barzilai and the use of digital signatures described in Bowman. However, it should be noted that the combined teachings nevertheless fail to teach digitally-signed privacy-use information because Bowman does not teach using digital signatures for privacy-use information.

Therefore, the combination of Barzilai and Bowman does not teach all of the limitations of the claim because the combination of cited references does not teach sharing digitally-signed privacy-use information with other business participants, as recited in the claim. Moreover, since the privacy-use information is only sent to the intermediate broker marketplace and is not exchanged between business participants, there is no need for the privacy-use information of Barzilai to be digitally signed. Accordingly, Appellants respectfully submit that claim 1 of the present application is patentable over the combination of cited references at least because the combination of Barzilai and Bowman does not teach all of the limitations of the claim.

Appellants respectfully assert independent claims 7 and 13 are also patentable over Haustein at least for similar reasons to those stated above in regard to the rejection of independent claim 1. In particular, the rejections of these claims merely rely on the same reasoning that the Office Action provided for the rejection of claim 1. Here, although the language of these claims differs from the language of claim 1, and the scope of each claim should be interpreted independently of claim 1, Appellants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejections of these claims.

Given that claims 2-6, 8-12, and 14-20 depend from and incorporate all of the limitations of the corresponding independent claims 1, 7, and 13, which are patentable over the cited references, Appellants respectfully submit that these dependent claims are also patentable over the cited reference based on allowable base claims. Additionally, each of these dependent claims may be allowable for further reasons. Accordingly, Appellants request that the rejections of claims 1-20 under 35 U.S.C. § 103(a) be withdrawn.

VIII. CONCLUSION

For the reasons stated above, claims 1-20 are patentable over the cited references. Thus, the rejections of claims 1-20 should be withdrawn. Appellants respectfully request that the Board reverse the rejections of claims 1-20 under 35 U.S.C. § 103(a).

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **09-0461** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **09-0461** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

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IX. CLAIMS APPENDIX

1.   (previously presented) A computer-implemented method of conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising the steps of:

the E-marketplace obtaining, via a computer, digitally-signed privacy-use information for each participant, wherein the digitally-signed privacy-use information is obtained separate from a business transaction between participants; and

the E-marketplace sharing, via said computer, the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace, wherein the sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace.

2.   (original) The method of claim 1, wherein said privacy information comprises a P3P policy.

3.   (previously presented) The method of claim 1, wherein said step of obtaining digitally-signed privacy-use information for each participant comprises at least the steps of:

requesting, via said computer, each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and

storing, via said computer, all of said submitted digitally-signed privacy-use information by the E-marketplace.

4.   (previously presented) The method of claim 1, wherein said step of obtaining digitally-signed privacy-use information for each participant comprises at least the steps of:

requiring each participant to submit, via said computer, said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and

storing, via said computer, all of said submitted digitally-signed privacy-use information by the E-marketplace.

5.   (previously presented) The method of claim 4, wherein said step of sharing the digitally-signed privacy-use information comprises at least the step of:

said E-marketplace making available, via said computer, all of said stored digitally-signed privacy-use information to all participants upon request.

6.   (previously presented) The method of claim 4, wherein said step of sharing the digitally-signed privacy-use information comprises at least the step of:

said E-marketplace making available to participants in a particular transaction, via said computer, the stored digitally-signed privacy-use information of all participants in said particular transaction.

7.   (previously presented) A computer program product recorded on computer-readable medium for conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising:

computer-readable means for the E-marketplace obtaining digitally-signed privacy-use information for each participant, wherein the digitally-signed privacy-use information is obtained separate from a business transaction between participants; and

computer-readable means for the E-marketplace sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace, wherein the sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace.

8.   (original) The program product of claim 7, wherein said privacy information comprises a P3P policy.

9.   (original) The program product of claim 7, wherein said computer-readable means for obtaining digitally-signed privacy-use information for each participant comprises at least:

      computer-readable means for requesting each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and

      computer-readable means for storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

10.   (original) The program product of claim 7, wherein said computer-readable means for obtaining digitally-signed privacy-use information for each participant comprises at least:

      computer-readable means for requiring each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and

      computer-readable means for storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

11.   (original) The program product of claim 10, wherein said computer-readable means for sharing the digitally-signed privacy-use information comprises at least:

      computer-readable means for making available by said E-marketplace all of said stored digitally-signed privacy-use information to all participants upon request.

12.   (original) The program product of claim 10, wherein said computer-readable means for sharing the digitally-signed privacy-use information comprises at least:

      computer-readable means for making available to participants in a particular transaction, by said E-marketplace, the stored digitally-signed privacy-use information of all participants in said particular transaction.

13.   (previously presented) A computer system for conducting electronic commerce transactions among a plurality of participants in an E-marketplace, comprising logic for:

obtaining digitally-signed privacy-use information for each participant, wherein the digitally-signed privacy-use information is obtained separate from a business transaction between participants; and

sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace, wherein the sharing allows the participants to verify that the digitally-signed privacy-use information has not been tampered with since being submitted to the E-marketplace.

14.   (previously presented) The computer system of claim 13, wherein said privacy information comprises a P3P policy.

15.   (previously presented) The computer system of claim 13, wherein said logic for obtaining digitally-signed privacy-use information for each participant comprises at least logic for:

requesting each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and

storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

16.   (previously presented) The computer system of claim 13, wherein said logic for obtaining digitally-signed privacy-use information for each participant comprises at least logic for:

requiring each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace; and

storing all of said submitted digitally-signed privacy-use information by the E-marketplace.

17.   (previously presented) The computer system of claim 16, wherein said logic for sharing the digitally-signed privacy-use information comprises at least logic for:

        making available by said E-marketplace all of said stored digitally-signed privacy-use information to all participants upon request.

18.   (previously presented) The computer system of claim 16, wherein said logic for sharing the digitally-signed privacy-use information comprises at least logic for:

        making available to participants in a particular transaction, by said E-marketplace, the stored digitally-signed privacy-use information of all participants in said particular transaction.

19.   (previously presented) The method of claim 1, wherein sharing the digitally-signed privacy-use information comprises the E-marketplace sending the digitally-signed privacy-use information of a potential business partner to a buyer in conjunction with the buyer requesting information regarding the potential business partner, prior to the buyer selecting to do business with the potential business partner.

20.   (previously presented) The method of claim 1, wherein sharing the digitally-signed privacy-use information comprises the E-marketplace sending the digitally-signed privacy-use information of a business partner to a buyer after the buyer selects to do business with the business partner.

X. EVIDENCE APPENDIX

There is no evidence submitted with this Appeal Brief.

XI. RELATED PROCEEDINGS APPENDIX

To the best of Appellants' knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.